

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. <b>09/877,549</b>	
Title: <b>SYSTEM AND METHOD FOR AUTOMATIC PERSONALIZING OF CHANNEL FAVORITES IN A SET TOP BOX</b>	
Inventor: <b>Michael FLORENCE</b>	Confirmation No. 9126
Filing Date: June 8, 2001	Examiner: Jason Salce
Attorney Docket No.: 50588/170	Group Art Unit: 2614

**REQUEST FOR PRE-APPEAL CONFERENCE**

TO THE COMMISSIONER FOR PATENTS:

The Applicant requests review of the final rejection of claims 1-3, 5-7, 9-15, 17-19, 21-26, 28-35, 61, and 90-98 in a Final Office Action dated February 14, 2007, in the above-identified application. Claims 36-39, 41-42, 52-53, 55-56, and 58-59 are also in the application and stand rejected, but review of the rejection of those claims is not requested at this time. The rejections of all of the claims for which review is sought are premised on U.S. Patent No. 5,801,747 ("Bedard").

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal, and the Applicant hereby petitions for a one-month extension of time and encloses the necessary fee. If the Commissioner believes that any additional fees are due, he is authorized to charge deposit account no. 19-4455.

**Reasons for Requesting Review**

***A. The Bedard Reference***

Bedard discloses a system that monitors television viewing activity to determine preferred channels and categories of programming for various viewers and then configures

the display of an electronic program guide (EPG) in accordance with a viewer's favorites. More specifically, Bedard's system provides a "viewer profile" for each viewer, which is based on the viewer's actual viewing behavior, as illustrated for example in Figure 1. Bedard's system builds a viewer profile array 200, as illustrated in Figure 2, which appears to be a table-like data structure in which viewing behavior is stored by channels and programming categories in terms of "viewing units." Bedard's system tracks viewing behavior by counting the discrete number of viewing units to approximately measure the time a channel is watched. Bedard states that the viewing unit can be "1 minute, 5 minutes, 10 minutes, etc." or "fifteen minutes in duration." (4:9-12)<sup>1</sup> If a viewer views a channel for less than this viewing unit, Bedard ignores that viewing activity.

Once Bedard's system has accumulated viewing activity data for a viewer and stored that data in the viewer profile array 200, Bedard uses that data to influence how an EPG is displayed for that viewer. In particular, Bedard discloses that the viewer's favorite channels (as measured by the raw number of viewing units) will be displayed at the top of the EPG, as explained at 7:39-41 and as shown in Figure 5. Bedard also discloses that the EPG may automatically surf through the viewer's favorite channels or channels presently showing programs in the viewer's favorite categories of programming. (7:41-45.)

Bedard also discloses a few other features, such as locking out viewing if the number of viewing units for a given category has reached a limit over a given period of time (e.g., block viewing sports after four hours in a week) (7:65 – 8:15); providing the information stored in the viewer profile array 200 to broadcasters so that they can better target programming or advertising (8:16-21); and suggesting other, unviewed channels or websites that provide similar content (8:22 – 9:3).

### ***B. Claims 1, 13, and 26***

Claims 1, 13, and 26 are in independent form. These claims stand rejected under as allegedly being anticipated by Bedard. Claim 1 is representative of this group for purposes of this request. Claim 1 reads as follows:

1. A method for generating a list of channel favorites in an interactive television system, comprising:
  - receiving a first notification, the first notification indicating a first channel activity;

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<sup>1</sup> References to Bedard are provided in this form: "4:9-12" means column 4, lines 9-12. References to the present specification are formatted similarly but with a leading page number rather than a column number.

receiving a second notification, the second notification indicating a second channel activity;  
calculating a time difference between the first and the second notifications; and  
updating a channel favorites table based on the calculated time difference, wherein the favorites tables includes a field that signifies a preference for a way in which the channel favorites are displayed.

Non-limiting examples of the “field that signifies a preference for a way in which the channel favorites are displayed” include items 402 and 442 in Figures 4A and 4B. The display preference 402 or 442 (Figures 4A and 4B) indicates whether the viewer’s favorite channels should be ordered in numerical order by channel number, by cumulative time watched, or by number of times watched, for example. Dependent claims recite some of these and similar possibilities.

Claim 1 stands rejected as allegedly being anticipated by Bedard. However, Bedard’s viewer profile array 200 contains no “field that signifies a preference for a way in which the channel favorites are displayed.” The viewer profile array simply contains channel entries 202, categories 208, and viewing unit counters 204 and 206. Notably absent from Figure 2 is any field that would indicate a preference as to a way to display the favorite channels. That is not surprising, given the fact that the only way in which Bedard’s system measures a viewer’s preference is by counting viewing units. Thus, Bedard’s system displays a viewer’s favorite channels in an order based on the number of viewing units logged on the channels in a table-style EPG, as explained at 7:8-27, or in an overlay EPG, as shown in Figure 5.

Nonetheless, the Examiner asserts that the fact that Bedard counts viewing units both by category (204) and subcategory (206) means that Bedard discloses “a field that signifies a preference for a way in which the channel favorites are displayed,” wherein the “preference” is allegedly by category or subcategory. The Examiner is speculating. While Bedard might conceivably be modified to have the flexibility to display channel favorites by viewing units either by category or by subcategory, Bedard does not disclose or suggest doing so. Bedard certainly does not disclose or suggest a field that signifies such a preference.

The Applicant therefore submits that the rejection of claims 1, 13, 26, and their dependent claims should be withdrawn, and those claims allowed.

### ***C. Claims 9, 21, and 31***

Claims 9, 21, and 31 are in independent form. These claims stand rejected as allegedly being anticipated by Bedard. Claim 9 is representative of this group for purposes of this request. Claim 9 reads as follows:

9. A method for generating a list of channel favorites in an interactive television system, comprising:  
    receiving a first notification, the first notification indicating a first channel activity;  
    receiving a second notification, the second notification indicating a second channel activity;  
    calculating a time difference between the first and the second notifications; and  
    updating a channel favorites table based on the calculated time difference, wherein the updating is performed if and only if the calculated time difference is larger than a threshold, wherein the threshold is ten seconds.

Claim 9 stands rejected as allegedly being anticipated by Bedard. This claim clearly recites a ten-second threshold. The Examiner, however, interprets the claim to read on any threshold equal to or larger than ten seconds. Thus, the Examiner contends that Bedard's 1-minute, 5-minute, 10-minute, or 15-minute thresholds satisfy this limitation. Because the Examiner's interpretation of the claim language is not reasonable, the Applicant requests that rejections of claims 9, 21, and 31 be withdrawn, and that those claims be allowed.

### ***D. Claims 25, 35, and 61***

Claims 25, 35, and 61 are in independent form. These claims stand rejected as allegedly being either anticipated by or obvious over Bedard alone or in combination with a secondary reference.

Each limitation of these claims is written in means-plus-function form and must be interpreted according to the statutory mandate of 35 U.S.C. § 112, ¶ 6. *In re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994); MPEP § 2182. Thus, to reject these claims requires that the Office make two showings for each limitation: (1) that Bedard discloses the identical function recited in the means-plus-function limitation and (2) that the Bedard's structure for performing that function be either the same as or equivalent to the corresponding structures in the Applicant's specification.

The Examiner did not initially perform step two of this required two-step analysis.

When challenged to do so, the Examiner boldly asserted that the second step is not required because equivalence of structure can be presumed when there is a showing of identical functions. When shown that such a view is incorrect, the Examiner responded merely by stating that "Bedard shows the equivalent structure at Column 3, Lines 6-8 by also teaching a set-top unit . . ." (Final Office Action at 3).

Such a broad-stroked structural comparison is not adequate. 35 U.S.C. § 112, ¶ 6 applies on a limitation-by-limitation basis, and the structural comparison must be similarly performed for each claim limitation that is governed by 35 U.S.C. § 112, ¶ 6. MPEP § 2181 ("It is necessary to decide on an element by element basis whether 35 U.S.C. 112, sixth paragraph, applies."). The Examiner's claim-as-a-whole approach is not supported by the statutory text, any case law or other authority. The Office much at least identify which part of Bedard's set-top unit performs the recited function and has the same or equivalent structure for each means-plus-function limitation. Unless and until the Office can do so for claims 25, 35, and 61, the Applicant cannot meaningfully respond. If the Office cannot do so, the claims must be allowed.


#### **Conclusion**

The simple and clear deficiencies in Bedard and in the Final Office Action require that the rejections discussed above be withdrawn. The claims identified above should promptly be allowed.

Respectfully submitted,

**Digeo, Inc.**

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